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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	110172.401	1291
500 7590 08/10/2007 SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 5400 SEATTLE, WA 98104			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/520,264

Applicant(s)

WEAVER ET AL.

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-78 and 80-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-78 and 80-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

This office action is in response to amendment filed on 03/28/2005.

Claims 51-78 and 80-97 are pending for examination, claims 1- 50 and 79 have been canceled; claims 51, 53-61, 64, 66-69, 71-72, 75, 77, 80-85, 87-88, 91, 93 and 96-97 have been amended.

A telephone interview has been conducted between the applicant's attorney (Dennis M. de Guzman) and the examiner (Susan Chen) on Feb. 8, 2007. During the interview, a discussion of the 35 U.S.C. § 112 issues as listed following are addressed and examiner indicates to withdraw the pre-mature objections on record. In reply, Applicant's representative requests to put the defects in writing and will amend the claims to reflect the novelty of instant invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51-78 and 80-97, are rejected under 35 U.S.C. 112, second paragraph, as being definite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 60, which recites the limitation “storing the recursively extracted electronic files in a searchable format in a first server unit using, including storing textual content of the recursively extracted electronic files in the searchable format in the first server unit” at lines 10-12, it is not clear what is the metes and bounds of the claimed “a searchable format” and “metadata”. In addition, what is it meant by “using, including storing textual content” (i.e., how an ordinary skilled artisan would use storing textual content of the recursively extracted electronic files in the searchable format in the first server unit to store the recursively extracted electronic files in a searchable format in a first server unit, when the applicant has never mentioned about storing textual content of the recursively extracted electronic files in a searchable format?) Moreover, the claimed “the metadata” at line 13 should be amended to “a metadata” for eliminating the lack of antecedent basis and the term “in a manner” should be further defined to the way that is supported by the instant specification. Furthermore, it uncertain what does the claimed “a specified characteristic” referred to (i.e., Does it referred to input query keywords? Or the characteristic relates to a conversation threading information? Or others?)

As to claim 69, this claim including at least the same defects of “a searchable format” and “metadata” as cited above, in the same token, the claimed “a displayable format” at lines 14-15 should be defined also.

As to claim 75, this claim including at least the same defects of “a searchable format”, “a displayable format” and “metadata” as cited above. Furthermore, the use of phrase “to cause a computer processor...” at lines 4-5 is not appropriate, because this term merely represents an intended operation of a computer processor that is not actually happened, hence, it renders the claim to be indefinite.

As to claim 82, this claim including at least the same defects of “a searchable format”, “a specified characteristic” and “metadata” as cited above. In addition, the phrase “a means” as recited throughout the claim renders the claim to be indefinite, because it is unclear if it represents a single mean or multiple means.

As to claim 85, this claim including at least the same defects of “a searchable format”, “a specified characteristic” and “metadata” as cited above. In addition, the phrases “to receive” (line 3), “to analyze”(line 4), “to convert” (line 8), “to obtain”(line 9), “to store”(lines: 10& 12), “to receive” (line 14) and “to process” (line 15) are intended functions that about to happen but unclear if they actually did, hence, it renders the claim to be indefinite.

As to claims 51-59, 61-68, 70-74, 76-78, 80-81, 83-84 and 86-97, these claims have the same defect as their base claims 60, 69, 75, 82 and 85, hence are rejected for the same reason.

Because the ambiguous nature of the claim language, the following art rejection is to the best of the examiner understanding.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 51-78 and 80-97, are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. Patent. No. 5,813,009), in view of Philip J. O'Shea et al. ("European Law Databases: an Experiment in Retrieval", IEEE 1997).

As to claim 60, Johnson discloses a method in a computer system [e.g. Abstract] for analyzing data produced for legal purposes comprising:

a) receiving, from an external information system that is external to the computer system, a plurality of electronic files that are stored in a data structure arranged according to a directory structure, that are subject to a legal proceeding , and that are produced by at least one party involved in the legal proceeding [e.g., col. 4, lines 45-59];

b) storing the received electronic files in a searchable format in a first server unit [e.g., storing Pre-Certified Data from ILM Capture to ILM database, Fig. 1C, col. 25, lines 55-67];

c) obtaining the metadata (or index) from each of the extracted electronic files and storing the metadata in a second server unit that preserves directory structure information of the received data structures [e.g., the Scan and Index section at col. 28, lines 49 col. 29, lines 47];

d) converting the extracted electronic files to a read-only format and storing the electronic files in the read-only format in a third server unit [e.g., col. 2, lines 2-7, col. 8, lines 30-36];

e) receiving a request for electronic files having a specified characteristic [e.g., col. 4, lines 49 – 59, col. 11, lines 2-8, col. 29, lines 10-19];

f) processing the metadata to determine a set of electronic files having the specified characteristic [e.g., col. 11, lines 2-49], thereby facilitating processing of the determined set of electronic files for legal purposes [e.g., col. 7, lines [e.g., col. 21, lines 35-38, col. 29, lines 10-46].

Johnson did not expressly disclose recursively extracting the plurality of electronic files from a plurality of paths of the directory data structure that is received from the external information system.

However, Philip J. O'Shea et al. (hereinafter referred as Philip) discloses the claimed features [e.g., Section: 4.6].

Johnson and Philip are both of the same endeavor to process network data produced for legal purposes via a directory (or index) data structure [e.g., Johnson: Abstract, lines 22-27, Fig. 8; Philip: Section: 2.1], hence, with the teachings of Johnson and Philip in front of him/her, an ordinary skilled person would have been motivated to modify Johnson's invention with the well-known technique as disclosed by Philip, because by doing so, the combined invention will be upgraded to support the document clustering and thereby facilitating the document classification.

As to claims 51-52, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the returning the indication of the determined set of electronic files includes returning a list of electronic files that contain content that matches the specified characteristic [e.g., Johnson: col. 10, lines 12-20, col. 11, lines 27- 32].

As to claim 53, in addition to the features as recited in claims 60, the combined system of Johnson and Philip further discloses that the method of storing the metadata (or indexing) in a data base of the second server unit [e.g., Johnson: col. 13, lines 7-65].

As to claim 54, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the received electronic files is stored in a searchable text format [e.g., Johnson: col. 16, lines 31 – col. 17, line 4, Philip: Section, 2.1].

As to claim 55, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that legal proceeding is a discovery proceeding that is part of a lawsuit, a mergers, an acquisitions proceeding or a due diligence effort [e.g., Johnson: Abstract, lines 22-27, col. 26, lines 34-44; col. 27, lines 6-17].

As to claim 56, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses the following as claimed:

a) the electronic files produced by at least one party involved in the legal proceeding [e.g., Johnson: col. 26, line 34-44, the audit loggings, col. 26, line 65 – col. 27, line 17];

b) receiving from the information system [e.g., Johnson: the External In-Coming Information system, Fig. 1A] that is external to the computer system [e.g., Johnson: the ILM Information Filter, Fig. 1A] for analyzing data for legal purposes [e.g., Johnson: Abstract, lines 22-25], at least some electronic files [e.g., Johnson: Audit Logging, col. 26, line 64] that have been previously exchanged between the at least one party [e.g. the Off-site party, Fig. 1C] and another party prior [e.g., Johnson: the Disposal party, Fig. 1C] prior to the legal proceeding, the external information system belonging to the at least one party of the legal proceeding [e.g., Johnson: the court of law, col. 27, line 11] and having stored therein these electronic files, [e.g., Johnson: col. 27, lines 6-17, Fig.(s) 1-Fig. 4 and associated texts].

c) wherein, the plurality of electronic files are received at the computer system during the legal proceeding, the computer system not belonging to any party of the legal proceeding [e.g., Johnson: the ILM system does not belong to the Off-site system, Fig. 1C].

As to claim 57, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the method of storing the metadata (or index) in the second server unit includes storing threading information associated with the emails [e.g., Johnson: Disposal of Records at col. 20 – 23, col. 28, lines 61-col. 29, line 19].

As to claim 58, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the method of receiving the plurality of electronic files including receiving word-processing file from the external information system [e.g., Johnson: col. 8, lines 57-59].

As to claim 59, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the method of storing the metadata (or indexing) in the second server unit includes storing metadata associated with a native format of each of the received electronic files [e.g., Johnson: col. 10, lines 65 – col. 11, lines 8; col. 15, lines 47-50].

As to claim 64, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that providing a user interface to display and apply at least one of the annotations [e.g., Johnson: col. 19, lines 50-58] including a responsive preparation selections to the electronic files having the specified characteristic and that are responsive to the request [e.g., Johnson: col. 15, lines 9-67, col. 28, lines 31- col. 30, line 64].

As to claim 65, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that the legal annotations include at least one of privileged, responsive annotations [e.g., Johnson: col. 18, line 63 - col. 19, line 6, col. 19, lines 50-58, col. 29, lines 55 – col. 30, lines 14].

As to claims 66-67, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that providing a summary information [e.g., the archived catalogue, col. 18, lines 4-6] indicative of electronic files that are available to be searched and processed to determine the set of electronic files having the specified characteristic [e.g., Johnson: Fig. 4 and associated texts].

As to claim 68, in addition to the features as recited in claim 60, the combined system of Johnson and Philip further discloses that receiving a request that specifies at least one of the properties information associated with the electronic file [e.g., Johnson: the speed keys processing based on user's request, col. 19, lines 25-31].

As to claims 69-78 and 80-97, these claims recite similar limitations as claims 60-68, with different wording method or in form of computer product or computer system, hence, are rejected for the same reason.

Response to Arguments

Applicant's arguments with respect to claims 60-78 and 80-97 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

To expedite the process of examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen
Examiner
Art Unit 2161

February 8, 2007